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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,118	10/25/2001	Mark R. Jolly	IR-2908(EV)	5687

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EXAMINER

BUTLER, DOUGLAS C

ART UNIT	PAPER NUMBER
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3683

DATE MAILED: 05/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/037,118

Applicant(s)

JOLLY ET AL.

Examiner

Douglas C. Butler

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2003.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.  
4a) Of the above claim(s) 4,5,8-10 and 13-36 is/are withdrawn from consideration.  
5) ☒ Claim(s) 1 is/are allowed.  
6) ☒ Claim(s) 2,3,6,7,11 and 12 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.  
10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.  
5) ☐ Notice of Informal Patent Application (PTO-152)  
6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

1. Prosecution on the merits is reopened in view of the below references.
2. An action on the merits of claims 1-3 , 6-7 and 11-12 considered readable on Species A(Figure 1 ) is included in this office action with claims 4-5, 8-10, 13-36 withdrawn from consideration pursuant to 37 CFR 1.142(b).
3. Claim 2, line 8 a comma should be inserted between "chamber" and "said".
4. Note previously furnished WO 03/036120 A2. The claims included therein are the same as original claims 1-36. The examiner stated during the examination of the international application that:

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The present application contains 37 claims, eight of which are independent. In view of the large number and also the wording of the claims presently on file, which render it difficult, if not impossible, to determine the matter for which protection is sought, the present application fails to comply with the clarity and/or conciseness requirements of Article 6 PCT (see also Rule 6.1(a) PCT) to such an extent that a meaningful search is impossible.

An analysis of the subject-matter of the claims with respect to the requirements of Rule 13.1 and 13.2 PCT would not have been possible without unreasonable effort.

Choosing a specific part of the application as the subject of a search would have been a purely arbitrary selection.

Consequently, no search report can be established for the present application.

The applicant's attention is drawn to the fact that claims relating to inventions in respect of which no international search report has been established need not be the subject of an international preliminary examination (Rule 66.1(e) PCT). The applicant is advised that the EPO policy when acting as an International Preliminary Examining Authority is normally not to carry out a preliminary examination on matter which has not been searched. This is the case irrespective of whether or not the claims are amended following receipt of the search report or during any Chapter II procedure. If the application proceeds into the regional phase before the EPO, the applicant is reminded that a search may be carried out during examination before the EPO (see EPO Guideline C-VI, 8.5), should the problems which led to the Article 17(2) declaration be overcome.

5. The examiner requests that applicants comment on the above disagreement between the prosecution in the instant application and the international application.

Have applicants challenged the findings in the PCT/US02/34270, which corresponds, to WO 03/036120 A2?

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 2-3, 6-7, 11-12 are rejected under 35 U.S.C. 102(b) as being anticipated by Carlson (US6117093).

The electronics 30, 32 of Figure 2 of Carlson are located in second chamber while the rotor 72, field controllable material 84 of chamber 68 are located in a first chamber which chamber is sealed from the first chamber by seals 76. Note rotatable shaft 50.

Note that Carlson is assigned to Lord Corporation. Although the examiner appreciates that Lord Corporation has numerous patents, the examiner request that applicants' and assignee review their records and inform the examiner as to the existence of any documents similar to the above.

8. Claims 6-7, 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Carlson(US6340080).

See Figure 35b of Carlson(US6340080) with rotor 140 located in a first chamber, filed controllable material 28, electronics in the from of a magnetic filed generator 80 situated in a second chamber.

9. Claim 1 is allowed.

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10. Note Carlson(US6427813) which teaches mounting electronic components externally or internally as per column 5, lines 47-51 which state:

29' of housing 22 as shown by dotted outlines 31', 31". As shown, the means for providing low-level magnetic field may be mounted internally within the hollow or externally therefrom. If mounted externally, ends of the housing should be non-magnetic.

11. Consider Annacchino et al.(4967887) with rotor 24 and filed controllable material 36 in Figure 1.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Douglas C. Butler whose telephone number is 703-308-2575. The examiner can normally be reached on m-f 5:30 am to 2pm.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Douglas C. Butler  
Primary Examiner  
Art Unit 3683

4-27-04